

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of: Osamu KOBAYASHI	Attorney Docket No.: GENSP047
Application No.: 10/762,680	Examiner: Shaifer Harriman, Dant B.
Filed: January 21, 2004	Art Unit: 2134
Title: PACKET BASED HIGH DEFINITION HIGH-BANDWIDTH DIGITAL CONTENT PROTECTION	Confirmation No.: 5247

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**CERTIFICATE OF EFS-WEB TRANSMISSION**

I hereby certify that this correspondence is being transmitted electronically through EFS-WEB to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on November 21, 2008.

Signed: \_\_\_\_\_/Lydie Fitzsimmons/  
Lydie Fitzsimmons

**REQUEST FOR RECONSIDERATION OF  
PATENT TERM ADJUSTMENT INDICATED IN  
NOTICE OF ALLOWANCE 37 C.F.R. § 1.705**

Mail Stop Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

1. This is a request for reconsideration of the patent term adjustment indicated in the Notice of Allowance mailed 10/21/08.

The issue fee is being paid as set forth in the papers attached hereto.

2. Applicant submits herewith a "Statement of the Correct Patent Term Adjustment: Basis(es) Under § 1.702 For the Adjustment - Part B." (37 C.F.R. § 1.705(b)(2)(i) and (iii)).

3. Any patent granted on this application (37 C.F.R. § 1.705(b)(2)(iii)).

is not subject to a Terminal Disclaimer.

is subject to a Terminal Disclaimer, and the expiration date specified in the Terminal Disclaimer is \_\_\_\_\_ (Date).

4. As to circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in § 1.704 (37 C.F.R. § 1.705(b)(2)(iv)):

there were none (37 C.F.R. § 1.705(b)(2)(iv)(B)).

these were as follows (37 C.F.R. § 1.705(b)(2)(iv)(A)).

83 days - See "Statement of the Correct Patent Term Adjustment: Basis(es) Under § 1.702 For the Adjustment - Part B" for details.

5. Also attached hereto is a "Request For Reinstatement For  All and/or  Part of the Period of Adjustment Reduced Pursuant to § 1.704(b) - Part C." (37 C.F.R. § 1.705(c)).

6. The fee set forth in § 1.18(e) \$200.00, required by 37 C.F.R. § 1.705(b)(1), is paid as follows:

to Deposit Account No. 50-4481 (Order No. GENSP047).

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

Respectfully submitted,  
BEYER LAW GROUP LLP

/Marc S. Hanish/  
Marc S. Hanish  
Registration No. 42,626

P.O. Box 1687  
Cupertino, CA 95015-1687  
408-255-8001

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Signed: \_\_\_\_\_/Lydie Fitzsimmons/  
Lydie Fitzsimmons

**STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT:  
BASIS(ES) UNDER § 1.702 FOR THE ADJUSTMENT  
(37 C.F.R. § 1.705(b)(2)(i) and (iii))**

Mail Stop Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This statement is being submitted in support of the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE" to which this statement is attached.

Applicant hereby requests reconsideration of the patent term adjustment indicated in the notice of allowance under 37 CFR 1.705. Specifically, Applicant respectfully maintains that in light of a recent binding court decision, Applicant is entitled to a total of 876 days, or an increase of 242 days over the 634 days granted in the notice of allowance.

### Statement of Facts

On September 30th, in the case of *Wyeth v. Dudas* (D.D.C. 2008), the District Court for the District of Columbia granted summary judgment in favor of Wyeth, determining that the U.S. Patent and Trademark Office had misconstrued 35 U.S.C. § 154(b)(2)(A), and as a result, had denied Wyeth a portion of patent term to which it was entitled under U.S. Patent Law. Summarizing the USPTO's take on § 154(b)(2)(A), the Court stated that "the PTO's view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for 'A delay' or for 'B delay,' whichever is larger, but never A + B." Wyeth, however, argued that the "A period" and "B period" overlap only if they occur on the same calendar day or days.

The Court determined that Wyeth's construction of § 154(b)(2)(B) was correct, stating that "[t]he only way that [A and B] periods of time can 'overlap' is if they occur on the same day."

In the present case, Applicant asserts that the PTO accurately calculated the "A" period (the delay between the 14 month anniversary of the filing date and the first office action) as 717 days. Applicant also asserts that the PTO accurately calculated the delay caused by the Applicant as 83 days. Applicant asserts, however, that under *Wyeth*, the PTO incorrectly has failed to credit 242 days owed to it under the "B" period (the delay between the 3 year anniversary of the filing date and the Request for Continued Examination , minus the days that the "A" period overlapped the "B" period on the same day).

Appendix A is a copy of the PTO's original calculation of Patent Term Adjustment as printed from PAIR for the present case. As can be seen from this document, the PTO correctly identified a period of 717 days from the date of the 14 month anniversary of the filing date of the application (3/21/05) to the date of the first non-final rejection (3/8/07). The PTO also correctly identified a period of Applicant delay of 40 days from the 3 month anniversary of the final rejection (9/26/07 is three months from the final rejection date of 6/26/07) to the date of the Applicant's response (the RCE date of 11/5/07). The PTO also correctly identified a period of Applicant delay of 43 days for filing an IDS after the mailing of a non-final office action (43 days measured from the filing of the RCE on 11/5/07 to the date of the IDS of 12/18/07).

Despite the accuracy described in the previous paragraph, the PTO failed to provide any determination of patent term adjustment based on the "B" period. This was of course standard practice in such circumstances prior to the *Wyeth* decision, but is incorrect now. Applicant has provided Appendix B, which shows the PTA calculation of Appendix A corrected in light of the *Wyeth* decision. Specifically, Applicant has identified a "B" period of 288 days. However, as shown in Appendix B, the "A" period overlaps the "B" period between 1/21/07 and 3/8/07, a period of 46 days. This results in an additional "B" period of 242 days that the Applicant is entitled to under *Wyeth* as being the portion of the uncredited "B" period not overlapping the "A" period.

Respectfully submitted,  
BEYER LAW GROUP LLP

/Marc S. Hanish/  
Marc S. Hanish  
Registration No. 42,626

P.O. Box 1687  
Cupertino, CA 95015-1687  
408-255-8001

# Appendix A: PTO's original calculation

[https://sportal.uspto.gov/secure/PA\\_1\\_0\\_1BP/PAIRPrintServ](https://sportal.uspto.gov/secure/PA_1_0_1BP/PAIRPrintServ)

10/762,680 PACKET BASED HIGH DEFINITION HIGH-BANDWIDTH DIGITAL  
CONTENT PROTECTION 11-20-2008::14:20:56

## Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/762,680

Filing or 371(c) Date:	01-21-2004	USPTO Delay (PTO) Delay (days):	717
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	83
Post-Issue Petitions (days):	+0	Total PTA (days):	634
USPTO Adjustment(days):	+0	Explanation Of Calculations	

## Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
10-21-2008	Mail Notice of Allowance		
10-11-2008	Document Verification		
10-11-2008	Notice of Allowance Data Verification Completed		
10-06-2008	Case Docketed to Examiner in GAU		
09-24-2008	Correspondence Address Change		
09-09-2008	Date Forwarded to Examiner		
09-09-2008	Mail Appeals conf. Reopen Prosec.		
09-08-2008	Pre-Appeals Conference Decision - Reopen Prosecution		
08-13-2008	Request for Pre-Appeal Conference Filed		
08-13-2008	Notice of Appeal Filed		
06-23-2008	Mail Final Rejection (PTOL - 326)		
05-27-2008	Final Rejection		
05-09-2008	Information Disclosure Statement considered		
05-09-2008	Information Disclosure Statement (IDS) Filed		
04-29-2008	Date Forwarded to Examiner		
03-27-2008	Response after Non-Final Action		
12-18-2007	Reference capture on IDS		
12-18-2007	Information Disclosure Statement (IDS) Filed	43	
01-08-2008	Mail Non-Final Rejection		↑
01-03-2008	Non-Final Rejection		↑
11-05-2007	Information Disclosure Statement considered		
12-18-2007	Information Disclosure Statement considered		↑
08-16-2007	Information Disclosure Statement considered		↑
11-07-2007	Information Disclosure Statement considered		↑
12-18-2007	Information Disclosure Statement (IDS) Filed		↑
11-07-2007	Information Disclosure Statement (IDS) Filed		↑
11-05-2007	Reference capture on IDS		↑
11-05-2007	Information Disclosure Statement (IDS) Filed		↑
11-09-2007	Date Forwarded to Examiner		↑
11-09-2007	Date Forwarded to Examiner		↑
11-05-2007	Request for Continued Examination (RCE)		40
11-09-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
11-05-2007	Request for Extension of Time - Granted		↑

11-07-2007	Information Disclosure Statement (IDS) Filed	↑
11-05-2007	Information Disclosure Statement (IDS) Filed	↑
11-05-2007	Workflow - Request for RCE - Begin	↑
08-29-2007	Mail Advisory Action (PTOL - 303)	↑
08-26-2007	Advisory Action (PTOL-303)	↑
08-22-2007	Date Forwarded to Examiner	↑
08-21-2007	Amendment after Final Rejection	↑
08-16-2007	Reference capture on IDS	↑
08-16-2007	Electronic Information Disclosure Statement	↑
08-16-2007	Information Disclosure Statement (IDS) Filed	↑
07-09-2007	Case Docketed to Examiner in GAU	↑
06-26-2007	Mail Final Rejection (PTOL - 326)	↑
06-20-2007	Final Rejection	↑
04-02-2007	Information Disclosure Statement considered	
04-02-2007	Information Disclosure Statement considered	
04-02-2007	Information Disclosure Statement considered	
04-16-2007	Date Forwarded to Examiner	
04-16-2007	Response after Non-Final Action	
04-02-2007	Reference capture on IDS	
04-02-2007	Information Disclosure Statement (IDS) Filed	
04-02-2007	Information Disclosure Statement (IDS) Filed	
04-02-2007	Information Disclosure Statement (IDS) Filed	
03-08-2007	Mail Non-Final Rejection	717
03-05-2007	Non-Final Rejection	↑
10-25-2006	Information Disclosure Statement considered	↑
01-03-2007	Information Disclosure Statement considered	↑
08-28-2006	Information Disclosure Statement considered	↑
05-15-2006	Information Disclosure Statement considered	↑
04-18-2006	Information Disclosure Statement considered	↑
02-01-2005	Information Disclosure Statement considered	↑
02-06-2006	Information Disclosure Statement considered	↑
01-03-2007	Reference capture on IDS	↑
01-03-2007	Information Disclosure Statement (IDS) Filed	↑
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04-27-2004	Application Dispatched from OIPE	↑
04-27-2004	Application Is Now Complete	↑
03-25-2004	Cleared by L&R (LARS)	↑
03-09-2004	Referred to Level 2 (LARS) by OIPE CSR	↑
02-03-2004	IFW Scan & PACR Auto Security Review	↑
01-21-2004	Initial Exam Team nn	↑

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# Appendix B: Applicant's Calculation

[https://sportal.uspto.gov/secure/PA\\_1\\_0\\_1BP/PAIRPrintServ](https://sportal.uspto.gov/secure/PA_1_0_1BP/PAIRPrintServ)

10/762,680 PACKET BASED HIGH DEFINITION HIGH-BANDWIDTH DIGITAL CONTENT PROTECTION		11-20-2008::14:20:56
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Post-Issue Petitions (days):	+0	Total PTA (days):
USPTO Adjustment(days):	+0	Explanation Of Calculations
<b>Patent Term Adjustment History</b>		
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08-28-2006 Information Disclosure Statement considered  
05-15-2006 Information Disclosure Statement considered  
04-18-2006 Information Disclosure Statement considered  
02-01-2005 Information Disclosure Statement considered  
02-06-2006 Information Disclosure Statement considered  
01-03-2007 3 year anniversary  
Reference capture on IDS  
01-03-2007 Information Disclosure Statement (IDS) Filed  
01-03-2007 Information Disclosure Statement (IDS) Filed  
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05-15-2006 Reference capture on IDS  
05-15-2006 Information Disclosure Statement (IDS) Filed

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05-15-2006	Information Disclosure Statement (IDS) Filed	↑
04-18-2006	Information Disclosure Statement (IDS) Filed	↑
04-18-2006	Information Disclosure Statement (IDS) Filed	↑
02-06-2006	14 month anniversary Reference capture on IDS	↑
02-06-2006	Information Disclosure Statement (IDS) Filed	↑
02-06-2006	Information Disclosure Statement (IDS) Filed	↑
02-01-2005	Reference capture on IDS	↑
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